

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY ZURAWSKI, SCOTT MARTIN and JAMES WARREN

Appeal No. 2001-0651
Application 08/134,187

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and FRANKFORT
and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, 26, 31 through 40, 56, 61 through 73, 92, 97 through 109, 128 and 341 through 354. Claims 15 through 25, 45 through 55, 78 through 91 and 114 through 127 stand allowed. Claims 11 through 14, 27 through 30, 41 through 44, 57 through 60, 74 through 77, 93 through 96, 110 through 113,

129 through 132 and 355 through 357, the only other claims remaining in the application, have been withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention. Claims 133 through 340 and 358 through 386 have been canceled.

Appellants' invention relates to (1) a method of making a token having a base portion of a desired metallic composition, a center area therein including a cavity carrying an imprinted disk having pictures or indicia thereon, and a protective outer coating filling the cavity for protecting the imprinted disk from wear and preventing scratching of the imprinted disk, and (2) a token formed by such method. While the specification focusses on gaming tokens such as those used in casinos, it is indicated (specification, page 5) that the term "token" is intended to include

not only gaming tokens that have designated denominational values and can be used in mechanical or electrical gaming devices or in live casino games, but also coins, medallions and tokens that have no casino gaming value, but rather are used as promotional items, collectible and commemorative items and may be bought and sold or traded by the general consuming public.

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A copy of representative claims 1, 10, 26, 61, 73 and 341, as found in the Appendix to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Copley	867	Apr. 2, 1861
Beinbrech	4,087,570	May 2, 1978
Bradshaw	4,263,734	Apr. 28, 1981
Prinz et al. (Prinz)	4,527,969	Jul. 9, 1985
Fabbiani	4,889,366	Dec. 26, 1989

Claims 1 through 5, 10, 31 through 35, 40, 73, 109, 341 through 348 and 350 through 354 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw.

Claims 6, 36 and 349 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw as applied above, and further in view of Beinbrech.

Claims 7 through 9 and 37 through 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw as applied above, and further in view of appellants'

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admitted prior art (AAPA) found in the specification at page 4,
line 9 through page 5, line 9.

Claims 26, 56, 92 and 128 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Copley in view of Bradshaw
and Fabbiani.

Claims 61 through 65, 71, 97 through 101 and 107 stand
rejected under 35 U.S.C. § 103(a) as being unpatentable over
Copley in view of Bradshaw as applied above, and further in view
of Prinz.

Claims 66, 72, 102 and 108 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Copley in view of Bradshaw
and Prinz as applied above, and further in view of Beinbrech.

Claims 67 through 69 and 103 through 105 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Copley in
view of Bradshaw and Prinz as applied above, and further in view
of AAPA.

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Claims 70 and 106 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw, Prinz and AAPA as applied above, and further in view of Beinbrech.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 28, mailed November 8, 2000) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 27, filed October 20, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the rejections before us on appeal, we observe that appellants have set forth, on page 6 of the brief,

three groupings of the claims. In accordance with the dictates of 37 CFR § 1.192(c)(7), we have selected claim 1 from the first grouping, claim 61 from the second grouping, and claim 26 from the third grouping, and we shall decide the issues before us on appeal on the basis of those claims alone. The remaining claims of each of the three groupings will stand or fall with the claim selected from the respective grouping.

Turning first to the examiner's rejection under 35 U.S.C. § 103(a) based on Copley in view of Bradshaw, we note that Copley discloses a form of "token" that falls within appellants' broad definition of this term set forth on page 5 of the specification. More specifically, Copley deals with a new and improved mode of ornamenting medals, buttons, and other similar articles of manufacture (e.g., collectible or commemorative medallions, or buttons, etc.). On page 3 of the examiner's answer, it is explained that Copley discloses a method of making a token that is similar to that set forth in appellants' claim 1 on appeal, with the exception that Copley does not teach the step of applying a protective coating over the inserted disk by filling

the cavity (aa) with a liquid protective coating as in step c) of claim 1 on appeal and then hardening the protective coating to prevent scratching of the imprinted disk.

To address this difference, the examiner turns to Bradshaw, urging that Bradshaw teaches placing an imprinted disk (23, 25) into a cavity (17) in the wall (13) of a molded article, and subsequently filling the cavity with a liquid protective coating that is then hardened to provide protection of the disk from damage. In the examiner's opinion,

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Copley filling each cavity aa with a liquid protective coating and hardening such to prevent scratching of the disk because Bradshaw teaches filling a cavity with a liquid protective coating and hardening such to prevent scratching of a decorative disk thereunder (answer, page 3).

Appellants argue (brief, pages 6-9) that Bradshaw is not concerned with metallic tokens, coins or medallions, but instead is directed to a method of making a ceramic article, and is thus non-analogous art to the field of appellants' invention.

Appellants further contend that the examiner is simply picking and choosing individual steps found scattered among prior art

references in order to build from hindsight the steps set out in appellants' claims. We do not agree with appellants' position.

In considering the question of non-analogous prior art for resolution of obviousness under 35 U.S.C. § 103, the law presumes full knowledge by the hypothetical worker having ordinary skill in the art of all the prior art in the inventor's field of endeavor. With regard to prior art outside the inventor's field of endeavor, knowledge is presumed only as to those arts reasonably pertinent to the particular problem with which the inventor was involved. See In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and In re Antle, 444 F.2d 1168, 170 USPQ 285 (CCPA 1971). Thus, the determination that a reference is from a non-analogous art is twofold. First, it must be decided if the reference is from within the inventor's field of endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was concerned.

In the present case, while we would agree with appellants that the Bradshaw reference is not within appellants' field of

endeavor relating to metal token minting, we nonetheless consider this reference to be analogous prior art because it satisfies the second prong of the above noted test, i.e., it is reasonably pertinent to the particular problem with which appellants were concerned. More specifically, appellants were seeking to provide a collectible or commemorative item that allows designs to be included in many forms on the item that are unique to each promoter, advertiser or business that desires to sell or give away such items, and wherein the process of manufacturing allows a portion of the item to be made using traditional printing operations so that designs can be include on the item that cannot be created by typical minting or casting operations (specification, page 6). In addition, it was recognized that the printed portions of such items would be subject to wear and have a tendency to be scratched so that the aesthetic benefits thereof would be short lived. To solve this problem, the printed portion (disk 30) was placed in a cavity (28) in the item and at least the printed portion of the item was covered with a protective coating so as to preserve the appearance of the printed portion during use. A review of the Bradshaw patent reveals that it deals with a similar problem.

More particularly, Bradshaw addresses a method of making and ornamenting a molded object or article of manufacture, such as a cup, or other container, or a wall ornament or plaque, that includes a recessed area (17) of predetermined shape in the exterior of the article wall and a sheet (23) having a picture, ornament or design thereon secured in the recessed area. The decorative sheet is then covered with a transparent plastic material snugly nested and molded into the recessed area sealingly overlying the sheet (col. 2, lines 1-12). The transparent plastic material is initially in liquid form and is flowed into the recess to fill the same and is then dried and hardened to form a permanent window or lens (29) over the sheet (23) having a picture, ornament or other design thereon. Note particularly, column 5, lines 27-68 of Bradshaw and column 6, lines 1-49 thereof.

Thus, we perceive the Bradshaw reference as being reasonably pertinent to the particular problem with which appellants were involved and conclude that it is analogous prior art. As a further point, we note that it is well settled that in cases involving relatively simple every-day mechanical concepts, like those involved in the present application, it is reasonable to

permit inquiry into other areas where one of even limited technical skill would have been aware that similar problems exist. See In re Heldt, 433 F.2d 808, 812, 167 USPQ 676, 679 (CCPA 1970).

In our evaluation of the applied prior art, we have considered all of the disclosure of the respective relied upon prior art for what it fairly teaches one having ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Further, we have taken into account not only the specific teachings of the prior art relied upon, but also the inferences which one skilled in the art would reasonably be expected to draw from each disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). In this regard, we note that we have presumed skill on the part of the artisan practicing the art here involved, rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

In considering the examiner's rejection of claim 1 we have relied upon the collective teachings of the applied prior art references to Copley and Bradshaw and, based on such teachings, must agree with the examiner that it would have been obvious to

one of ordinary skill in the art at the time of appellants' invention to provide the method of making the medal seen in Figures 1 through 3 of Copley with an added step of filling each cavity (aa) with a liquid protective coating material and then hardening that material to define a protective coating over the imprinted disk which would prevent scratching of the imprinted disk as taught or suggested in Bradshaw.

Contrary to appellants' assertions, we do not consider that the examiner has relied upon impermissible hindsight in choosing to include the protective coating taught in Bradshaw in the medallion of Copley to afford the pictures in the recesses or cavities (aa) therein a level of protection not provided by Copley. Instead, we consider that the examiner was merely following the teachings of Bradshaw which would have been readily apparent to one of ordinary skill in the art at the time of appellants' invention regarding protection of a sheet bearing pictures, ornamentation or a design as part of an article such as a wall ornament or plaque, wherein the sheet bearing pictures, ornamentation or a design is placed in a recess or cavity in an article of manufacture and then covered with a protective plastic coating that sealingly overlies the sheet and thus protects it

from being scratched or otherwise damaged. Thus, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103(a).

In accordance with appellants' grouping of the claims (brief, page 6), we consider that claims 2 through 10, 31 through 40 and 341 through 354 will fall with claim 1. It follows that the examiner's respective rejections of those claims under 35 U.S.C. § 103(a) will also be sustained.

Claim 61 has been selected as being representative of appellants' second group of claims set forth on page 6 of the brief. Claim 61 is similar to method claim 1, but further includes the step of "preheating the imprinted disk to alter the surface energy of the imprinted disk whereby a protective coating will more securely adhere to the imprinted disk." This claim stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw as applied above, and further in view of Prinz.

In the examiner's view, Prinz provides a teaching of preheating foils or film materials formed of plastic, paper or metal via a corona discharge treatment that alters the surface

energy of the film material and enables or enhances further processing, such as printing or bonding (col. 2, lines 3-11). Based on this teaching and the teachings in Copley and Bradshaw, the examiner has concluded that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to provide a preheating step for the disk/picture in the method of formation of the medallion in Copley as modified by Bradshaw so as to alter the surface energy of the disk/picture material and thus enable or enhance further processing, such as bonding of the protective coating of Bradshaw to the disk/picture. We agree with the examiner.

In response to appellants' argument (brief, page 11) that Prinz is non-analogous art, while we would agree with appellants that Prinz is not within their field of endeavor in the metal token minting art, we nonetheless consider that Prinz is reasonably pertinent to the problem addressed by appellants (specification, page 15) regarding a corona discharge treatment of the imprinted disks (30) therein which alters the surface energy of the imprinted disks so that the protective coating (40) will adhere more securely thereto. Thus, we conclude that Prinz is analogous prior art and was properly considered by the

examiner in reaching the above-noted obviousness conclusion. Moreover, as we noted above, we are in agreement with the examiner's reasoning and conclusion that the combined teachings of Copley, Bradshaw and Prinz would have rendered obvious the method set forth in claim 61 on appeal. Accordingly, we will sustain the examiner's rejection of claim 61 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw and Prinz.

As for claims 62 through 73 and 97 through 109, these remaining claims of appellants' second grouping of claims on appeal are considered to fall with claim 61 and, thus, the examiner's rejections of those claims under 35 U.S.C. § 103(a) are likewise sustained.

In further response to appellants' arguments above, we observe that where the issue is one of obviousness under 35 U.S.C. § 103, the proper inquiry should not be limited to the specific structure shown by a reference, but should be into the concepts fairly contained therein, with the overriding question to be determined being whether those concepts would have suggested to one skilled in the art the modification called for

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by the claims. See In re Bascom, 230 F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956). As stated by the Court in In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Appellants' third grouping of claims set forth on page 6 of the brief includes claims 26, 56, 92 and 128. Each of these claims is a product-by-process claim which directly references an allowed method claim, i.e., respectively, allowed claims 15, 45, 78 and 114. Claim 26 is directed to "The token made by the method of Claim 15." Claims 56, 92 and 128 are similarly directed to a token, respectively, made by the methods of claims 45, 78 and 114.

Allowed claim 15 reads as follows:

15. A method of making a token having a minted portion and an imprinted portion comprising:

a) providing a metal blank having the desired metallic composition to a token, the metal blank having a border area and a center area, the center area including a cavity;

b) inserting an imprinted disk in the cavity of the token;
and

c) filling a portion of the cavity with a first protective coating and the remainder of the cavity with a second protective coating to prevent scratching of the imprinted disk.

Claim 15 differs from claim 1 on appeal in that the last step of the claim requires "filling a portion of the cavity with a first protective coating and the remainder of the cavity with a second protective coating to prevent scratching of the imprinted disk." As noted in the specification (page 21), the first protective coating (140) and the second protective coating (142) are distinct layers of different coating material. Each of the other allowed claims 45, 78 and 114 includes a step like that set forth in claim 15.

Claims 26, 56, 92 and 128 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw and Fabbiani, with Copley and Bradshaw being combined by the examiner as in the rejection of claim 1 discussed supra. Fabbiani is relied upon by the examiner as teaching a security document including layers (2) and (5) which are respectively a support and a hologram. The examiner points to Figure 3 of

Fabbiani and its layers (10a, 10b), wherein a portion of layer (10b) which covers the hologram (5) also covers a portion of the layer (10a) that is applied to the support (2). The examiner further notes that Fabbiani indicates that one protective coating layer could also be used. From those teachings the examiner has concluded that

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Copley a protective coating in each cavity to prevent scratching of the disk where the protective coating includes a first protective layer and a second layer [sic] protective layer because Bradshaw teaches a protective coating within a cavity prevent scratching of a decorative disk thereunder and Fabbiani teaches that for a similar product (small hand-held exchangeable item bearing information) one can use one or two protective coatings and it is obvious to replace one protective coating (one layer in Copley, modified,) with another art recognized protective coating (two layers as shown by Fabbiani) (answer, page 6).

Like the examiner, we note that claims 26, 56, 92 and 128, as well as the other product-by-process claims in this application, are independent claims written in a shorthand format and are not dependent claims. In each of claims 26, 56, 92 and 128 on appeal, the token defined therein includes an imprinted disk inserted into a cavity in the metal blank, a first protective coating partially filling the cavity and the remainder of the cavity being filled with a second protective coating.

Thus, each of the tokens defined in claims 26, 56, 92 and 128 includes a cavity with an imprinted disk therein and two distinct layers of protective coating in the cavity over the imprinted disk.

It is by now well settled that product claims may be drafted to include process steps to wholly or partially define the claimed product, and that to the extent that the process limitations distinguish the claimed product from the prior art, they must be given the same consideration as traditional product characteristics or limitations. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981). This type of claim is referred to as a product-by-process claim and, as noted in In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), does not inherently conflict with the second paragraph of 35 U.S.C. § 112. However, due to the lack of physical description in a product-by-process claim, this form of claim does impose a certain burden with regard to determining the patentability thereof, since in spite of the fact that the claims may recite only process limitations, it is the patentability of the product claimed and not the recited process steps which must be established. Accordingly, when the prior art discloses a product which

reasonable appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. *Id.*, at 688. The rationale for this conclusion is that the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. Thus, this burden is shifted to appellants in those instances where prior art is applied by the examiner against product-by-process claims and appellants must specifically point out or demonstrate how the process limitations structurally distinguish the claimed product from the product of the prior art, which may be made by a different process.

As is apparent from the above-noted case law, appellants are normally only put to the burden of specifying the exact structural limitations imposed on the claimed product by the process limitations when the examiner has applied prior art which teaches, discloses or makes obvious a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim. This the

examiner has not done in the present application. More specifically, we do not see that the references relied upon by the examiner (Copley, Bradshaw and Fabbiani) in any way teach or suggest a token having a cavity with an imprinted disk therein and two distinct layers of protective coating within the cavity over the imprinted disk, as required of the token set forth in claims 26, 56, 92 and 128 on appeal. For that reason, we will not sustain the examiner's rejection of claims 26, 56, 78 and 128 under 35 U.S.C. § 103(a).

In conclusion, we note that the examiner's rejection of claims 1 through 5, 10, 31 through 35, 40, 73, 109, 341 through 348 and 350 through 354 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw has been sustained. We have also sustained the examiner's rejections of 1) claims 6, 36 and 349 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw and Beinbrech; 2) claims 7 through 9 and 37 through 39 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw as applied above, and further in view of appellants' admitted prior art (AAPA) found in the specification at page 4, line 9 through page 5, line 9; 3) claims 61 through 65, 71, 97 through 101 and 107 under 35 U.S.C. §

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103(a) as being unpatentable over Copley in view of Bradshaw and Prinz; 4) claims 66, 72, 102 and 108 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw, Prinz and Beinbrech; 5) claims 67 through 69 and 103 through 105 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw and Prinz as applied above, and further in view of AAPA; and 6) claims 70 and 106 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw, Prinz, AAPA and Beinbrech.

However, the examiner's rejection of claims 26, 56, 92 and 128 under 35 U.S.C. § 103(a) as being unpatentable over Copley in view of Bradshaw and Fabbiani has not been sustained.

Accordingly, the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

BRUCE H. STONER, Jr.)	
Chief Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

CEF:pgg

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ATTACHMENT

1. A method of making a token having a minted portion and an imprinted portion comprising:

a) providing a metal blank having the desired metallic composition of a token, the metal blank having a border area and a center area, the center area including a cavity;

b) inserting an imprinted disk in the cavity of the token;
and

c) filling the cavity with a first protective coating in liquid form and then hardening the first protective coating to prevent scratching of the imprinted disk.

10. The token made by the method of Claim 1.

26. The token made by the method of Claim 15.

61. A method of making a token having a minted portion and an imprinted portion comprising:

a) providing a metal blank having the desired metallic composition for a token; the metal blank having a border area and a center area, the center area including a cavity;

b) inserting an imprinted disk in the cavity of the token;

c) preheating the imprinted disk to alter the surface energy of the imprinted disk whereby a protective coating will more securely adhere to the imprinted disk;

d) filling the cavity with a first protective coating in liquid form to prevent scratching of the imprinted disk; and

e) curing the first protective coating to harden the protective coating so that the protective coating will be scratch resistant.

73. The token made by the method of Claim 61.

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341. A token comprising:

a) a metal blank having a border area with minted indicia therein and a central area having a cavity;

b) an imprinted disk mounted in the cavity; and

c) a protective coating, initially in liquid form, filling the cavity, and then hardened to prevent scratching of the imprinted disk.